



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,392	04/19/2004	Jonah Staw	61145.129	3113
27128 7590 12/03/2009 HUSCH BLACKWELL SANDERS LLP 190 Carondelet Plaza Suite 600 ST. LOUIS, MO 63105				
EXAMINER				
ZURITA, JAMES II				
ART UNIT		PAPER NUMBER		
3625				
NOTIFICATION DATE		DELIVERY MODE		
12/03/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pto-sl@huschblackwell.com

Office Action Summary

Application No.

10/827,392

Applicant(s)

STAW ET AL.

Examiner

JAMES ZURITA

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/17/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8,9,11-13,15-18 and 21-43 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8,9,11-13,15-18 and 24-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

On 07/17/09, applicant cancelled claims 2, 7, 10, 14 and 19-20. Applicant added claims 24-43. Applicant amended claims 1, 3-6, 8, 9, 11-13, 15-18.

Claims 1, 3-6, 8-9, 11-13, 15-18 and 21-43. Of these, claims 21-23 are withdrawn from prosecution as being directed to a non-elected invention.

Claims 1, 3-6, 8-9, 11-13, 15-18 and 24-43 will be examined. Claims 1, 35 and 43 are independent.

Response to Arguments

Applicant's arguments filed 07/17/09 have been fully considered.

Objections and rejections are withdrawn in view of amendment.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 35 and 43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedence see *Diamond v Diehr* 450 US 175,184 (1981); *Parker v. Flook*, 437 US 584,588,n. 9 (1978); *Gottschalk v Benson*, 409 US 63, 70 (1972); *Cochrane v Deener*, 94 US 780, 787-88 (1876) a 101 process must (1) be tied to another statutory class (such as an apparatus) or transform underlying subject

Art Unit: 3625

mater (such as an article or materials) to a different state or thing. Since neither of these requirements is met by the claim the claim is rejected as being directed to non-statutory subject matter.

The Examiner suggests the following amended language to correct the claims:

1. A method for coordinating non-matching patterns on selected items developed from placing design features on the selected items by a computer in a particular manner comprising:

Identifying by the computer, at least one item;

Selecting by the computer, at least two different design features for use in developing non-matching patterns for placement on the at least one identified item;

Placing by the computer, at least one of the at least two different selected design features on at least one of at least two of the identified item and placing the other of said two different selected design features on the other of said at least two of the identified item to form at least one pattern on each such item; and

Coordinating by the computer, the placement of the selected design features on at least two of the identified items such that the at least one pattern formed on one such item is non-matching when compared to the at least one pattern formed on each of the other items.

35. A method for coordinating dissimilar patterns on selected items developed from placing design features on the selected items by a computer, in a particular manner comprising:

Identifying by the computer, at least one item;

Selecting by the computer, at least two different design features for use in developing dissimilar patterns for placement on the at least one identified item;

placing by the computer, at least one of the two different selected design features on at least one of the at least two of the identified item and placing the other of said at least two different selected design features on the other of said at least two of the identified item to form at least one pattern on each such item; and

coordinating by the computer, the placement of the selected design features on at least two of the identified items such that the at least one pattern formed on one such item is dissimilar to the at least one pattern formed on each of the other items.

43. A method for coordinating variegated patterns on selected items developed from placing design features on the selected items by a computer, in a particular manner comprising:

Identifying by the computer, at least one item;

Selecting by the computer, at least two different design features for use in developing variegated patterns for placement on the at least one identified item;

Placing by the computer, at least one of the at least two different selected design features on one of at least two of the identified item and placing the other of said at least two different selected design features on the other of said at least two of the identified item to form at least one variegated pattern on each such item; and

Coordinating by the computer, the placement of the selected design features on at least two of the identified items such that the at least one variegated pattern formed on

one such item is dissimilar to the at least one variegated pattern formed on each of the other items.

Claim Objections

Claims 3-6, 8-9, 11-13, 15-18, 24-34 and 36-43 are objected to as being dependent from rejected claims 1, 35 and 43.

Allowable Subject Matter

Claims 1, 3-6, 8-9, 11-13, 15-18 and 24-43 would be allowable if rewritten to overcome all rejections and objections raised herein.

The following is an examiner's statement of reasons for indicating allowable subject matter.

Applicant's arguments and amendments are commensurate with the disclosures as filed. Applicant's amendment to the specifications is particularly helpful in defining his invention. See paragraph 0137, amendment of 07/17/2009, pages 4-5. Updated searches were performed using the amended claims language.

The closest US prior art, Feld, US 2001/0026272, neither anticipates nor renders obvious the combination, inter alia of representative claim 1:

Identifying at least one item;
Selecting at least two different design features for use in developing non-matching patterns for placement on the at least one identified item;
Placing at least one of the at least two different selected design features on at least one of at least two of the identified item and placing the other of said two different selected design features on the other of said at least two of the identified item to form at least one pattern on each such item; and
Coordinating the placement of the selected design features on at least two of the identified items such that the at least one pattern formed on one such item is non-matching when compared to the at least one pattern formed on each of the other items.

The closest Non-patent literature is

Tina Cassidy, Making Waves, Boston Globe, Boston, May 2, 2002, downloaded from ProQuest Direct on the Internet on March 4, 2009, 4 pages.

Also of interest are the following:

Jennifer Frey, Deion's DC Duds, Washington Post, 7 June 2000, downloaded from ProQuest Direct on the Internet on 4 March 2009, 6 pages.

Laura Liebeck, 1994 Power Brands, Discount Store News, New York, 10/03/1994, downloaded from ProQuest Direct on the Internet on 4 March 2009, 25 pages.

Judy Hevrdeis, 5 that annoy, 5 that would ensure joy, Knight Ridder Tribune News Service, Washington, March 10, 1994, downloaded from ProQuest Direct on the Internet on 4 March 2009, 2 pages.

Terri Finan, Thinking Outside the Box, Club Management, St. Louis, Jul/Aug 1999, vol 78, Issue 4, page 85, downloaded from ProQuest Direct on the Internet on 4 March 2009, 5 pages.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/
James Zurita
Primary Examiner
Art Unit 3625
22 November 2009